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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/817,107	04/02/2004	John W. Pastmak	IL-11131	2882

7590 07/27/2005

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EXAMINER

JOHNSON, STEPHEN

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/817,107

Applicant(s)

PASTRNAK ET AL.

Examiner

Stephen M. Johnson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/2/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. This application contains claims directed to the following patentably distinct species of the claimed invention: Species A is illustrated in figs. 1-3. Species B is illustrated in figs. 4-5. Species C is illustrated in figs. 6-7.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that **a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added.** An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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2. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "high-strength" and/or "low-density" throughout the claims are relative terms which renders the claim indefinite. The terms "high-strength" and/or "low-density" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Usage of these terms to describe the strength and/or density of the composite fiber and matrix material makes the claims indefinite for the reasons given above.

In claims 5 and 7, use of the terminology in parenthesis makes the claims indefinite as to whether or not the terminology so included is limiting to the claim language. In claim 5, lines 2-3, how are the terms "an inner ring" and "an outer ring" intended to relate to the previously claimed "at least two telescoping cylindrical rings" (see claim 1, line 2)? In claims 5, 6, and 7, the phrase "the handle-associated ring" lacks an antecedent. In claim 7, line 4, the phrase "the foot-hold-associated ring" lacks an antecedent.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 5-7, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Fimiani.

Fimiani discloses a portable convertible blast shield comprising:

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|--|----------------------|
| a) at least 2 telescoping cylindrical rings; | 5, 8 |
| b) a telescopically-collapsed configuration; | see fig. 3 |
| c) a telescopically-extended configuration; | see fig. 1 |
| d) means for releaseably securing; | 9, 10, 11, 12 |
| e) handles; | 13 |
| f) at least one foot hold; and | 13 or 14 or 15 or 16 |

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fimiani in view of Tabor.

Fimiani applies as previously recited. However, undisclosed is an armor material that is comprised of a composite fiber and matrix material. Tabor teaches an armor material that is comprised of a composite fiber and matrix material (col. 4, lines 8-28). Applicant is substituting one armor material for another in an analogous art setting. It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Tabor to the Fimiani shield and have a shield with a different or particular type of armor material.

7. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fimiani in view of Chaires or Larnell.

Fimiani applies as previously recited. However, undisclosed is a pair of wheels for aiding

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in mobility of the portable shield. Chaires (#21) and Larnell (#13, #21) each teach a pair of wheels for aiding in mobility of the portable shield. Applicant is selecting a means to aid in shield mobility and putting it to use as it is already commonly known to be used in this art. It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Chaires or Larnell to the Fimiani shield and have a shield with the addition of wheels to aid in mobility.

8. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Finiani in view of Tabor as applied to claims 1-3, 5-7, and 11 above, and further in view of Chaires or Larnell.

Fimiani and Tabor apply as previously recited. However, undisclosed is a pair of wheels for aiding in mobility of the portable shield. Chaires (#21) and Larnell (#13, #21) each teach a pair of wheels for aiding in mobility of the portable shield. Applicant is selecting a means to aid in shield mobility and putting it to use as it is already commonly known to be used in this art. It would have been obvious to a person of ordinary skill in this art at the time of the invention to apply the teachings of Chaires or Larnell to the Fimiani in view of Tabor shield and have a shield with the addition of wheels to aid in mobility.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fimiani in view of Clemens.

Fimiani applies as previously recited. However, undisclosed is an armor material that contains a ceramic liner. Clemens teaches an armor material that contains a ceramic liner (col. 3, lines 6-15). Applicant is substituting one type of armor material in an analogous art setting. It would have been obvious to a person of ordinary skill in this art at the time of the invention to

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apply the teachings of Clemens to the Fimiani armor shield and have an armor shield with a particular or different type of armor material.

10. Claims 1, 5-7, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Dorfman.

Dorfman discloses a portable convertible blast shield comprising:

- a) at least 2 telescoping cylindrical rings; 5
- b) a telescopically-collapsed configuration; see fig. 1
- c) a telescopically-extended configuration; see fig. 2
- d) means for releaseably securing; 6, 7, 12
- e) handles; 11
- f) at least one foot hold; and 9

11. Claims 10 and 12-15 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. Claims 16-21 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

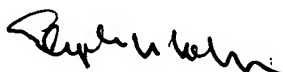
13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Fraser, Graham et al., Kovacs, Thrash, and Cushman disclose other state of the art convertible shields.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. Johnson whose telephone number is 571-272-6877. The examiner can normally be reached on Tuesday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571-272-6873. The fax phone number for the organization where this application or proceeding is assigned are 703-872-9306. As of July 15, 2005, the fax phone number for the organization where this application or proceeding is assigned will change to 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 800-786-9199.



STEPHEN M. JOHNSON
PRIMARY EXAMINER

Stephen M. Johnson
Primary Examiner
Art Unit 3641

SMJ
July 13, 2005